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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,280	01/30/2002	Terumi Matsuda	2091-0249P	2656

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,280

Applicant(s)

MATSUDA ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 28, 2006 has been entered.

Response to Amendment

Applicants' "Amendment Under 37 CFR 1.111" filed July 28, on has been considered with the following effect.

Applicants' response by virtue of amendment to claim 20 has overcome the Examiner's rejection under 35 USC § 101 and 35 USC § 112, second paragraph.

Applicants' response by virtue of amendment to claim 21 has not overcome the Examiner's rejection under 35 USC § 101 and 35 USC § 112, second paragraph.

Claims 1, 13, and 17 are amended. New claims 23-25 are added. Claims 1-25 remain pending in this application and an action on the merits follows.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because it fails to recite **computer executable** instructions. The claims are directed to machine-**readable** medium. Giving

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the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106. For example, the claim can recite "a computer-readable medium having computer-executable instructions which, when executed on a computer, comprising:".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by
U.S. Patent No. 6,573,927 to Parulski et al.**

Regarding claims 20-21, Parulski discloses a program and a computer-readable medium comprising: generating order information regarding image data to be printed, to be printed, the order information includes at least the image data to be printed, information indicating a print size of the image data, and information indicating a print quantity of the image data (col. 3, lines 45-59); reading access information indicating at least a specific photograph processing agency available to access and an order reception server installed in the specific photographic processing agency and utilized for directly accessing the order reception server (col. 3, lines 5-67); and transferring the

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ordering information to the order reception server installed in the specific photograph processing agency by directly accessing the order reception server according to the access information (col. 3, lines 5-67); and access information area (col. 3, lines 5-67)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,573,927 to Parulski et al. in view of U.S. Patent No. 7,069,237 to Tate.

Regarding claims 1, 10-11, 13 and 16-17, Parulski discloses an order reception server enabling reception of order information regarding image data via a network and installed respectively in a photograph processing agency having a photographic printer for printing the image data (service provider ref. 14; Figure 1B; col. 2, lines 55-56; col. 3, lines 3-9); and an order terminal directly connectable via the network to the order reception server in the photograph processing agency, the order terminal generating the order information and placing an order for a print of the image data by directly transferring the order information to a corresponding one of the order reception server installed in one of the photograph processing agency after directly accessing the order reception server of the specific photograph processing agency (Digital Camera ref. 12,

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Figure 1A; col. 3, lines 3-11; col. 3, lines 30-44). Furthermore, Parulski discloses an order terminal (kiosk, ref. 16, Figure 1B) installed in a photographic processing agency, the photographic processing agency having a photographic printer for outputting image data as a print, the order terminal being directly connectable via a network to an order reception server in photographic agency, the order reception servers enabling reception of order printing system install in a photographic processing agency (**claim 17**) (col. 2, lines 53-56; col. 2, line 65 – col. 3, line 3; col. 3, line 67 – col. 4, line 3;). Parulski discloses a charge of the print (col. 3, lines 64-67); and the order terminal is directly connectable via the network to the order reception server, rather than via an order reception center (**claims 23-24**) (Figure 1A and Figure 1B; col. 2, lines 53-col. 3, line 3).

However, Parulski does not explicitly disclose a plurality of photograph processing agencies and a plurality of reception servers; time of delivery; and status of printing. Parulski does disclose a digital camera which incorporates or be connected to a wired or wireless modem such as the communication interface. The print order information and the image information needed to fulfill the print order would be transmitted to the service provider along with the account information through the communication network. (Col. 4, lines 9-16) The user can specify the names of downstream service providers (col. 3, lines 7-9). The service providers include a computer and printer (Figure 1B, ref. 14).

Tate, on the other hand, teaches the plurality of photograph processing agencies and a plurality of reception servers (numerous service providers, col. 4, lines 58-62; col. 3, line 67 – col. 4, line 2). Furthermore, Tate teaches time of delivery; and status of

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printing (col. 5, lines 17-20; col. 6, lines 28-37; col. 6, lines 64-67) (**claims 10-11 and 16**).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system and terminal of Parulski, to include plurality of photograph processing agencies and a plurality of reception servers, in order to provide

Regarding claims 2 and 18, Parulski discloses the order information is generated and transferred by a program installed in the order terminal (col. 3, lines 5-24; col. 4, lines 20-23).

Regarding claims 3-5, 14 and 19, Parulski discloses a program is recorded in a recording medium (disc), the recording medium further recorded with access information used for accessing the order reception server of the specific photograph processing agency, and the order terminal reads the access information from the recording medium; the photograph processing agency have recording means for recording the access information in the recording medium; and wherein the access information used for accessing the order reception server of the specific photograph processing agency is recorded in a recording medium and the order terminal reads the access information from the recording medium (col. 3, lines 5-67).

Regarding claims 6-9, 12, and 15, Parulski discloses wherein the access information used for accessing the order reception server of the agency is printed on a printing medium and the order terminal reads the access information from the printing medium (col. 3, lines 60-col. 4, line 3); wherein the access information is obtained a

predetermine Web server and the order terminal access the order reception server (col. 4, line 61-col. 5, line 15); wherein information used for accessing the order reception server of the specific agency and obtains photographic processing agency information regarding the specific photograph processing agency (col. 3, lines 5-11; col. 3, lines 25-44; col. 4, lines 17-27); attachment information output means for printing attachment information to be attached to the print (col. 3, lines 5-24; col. 4, lines 17-28); and access information for directly accessing an order reception server installed in a photograph processing agency (col. 3, lines 5-11; col. 3, lines 25-44).

Regarding claim 22, Parulski discloses the order terminal is a personal computer connectable to the network and owned by the user for placing the print order (Figure 1A; col. 2, lines 53-54).

Response to Arguments

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

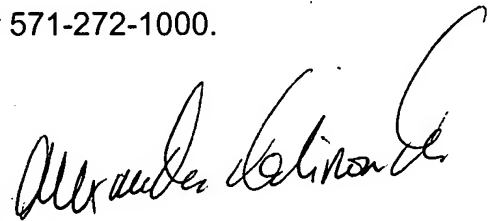
U.S. Patent No. 6,950,198 to Bararducci et al. discloses an effective method of transferring images from a user to a service provider.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
October 16, 2006



ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER